



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/542,852

07/21/2005

Adolf Kaser

PD/3-22827/A/PCT

9185

324 7590 04/03/2008

JoAnn Villamizar
Ciba Corporation/Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591

EXAMINER

KHAN, AMINA S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,852	Applicant(s) KASER ET AL.	
	Examiner AMINA KHAN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacroix (US 4,111,650) in view of Pedrazzi (US 5,665,871).

Lacroix teaches dyeing paper pulp with compositions comprising 15-50, preferably 20-25 % % dyes of the instantly claimed formula (1), water, 8-12% N-methylpyrrolidone, 4-6% benzyl alcohol, and 4-5% formic acid (column 1, lines 5-40; column 2).

Lacroix does not teach compositions comprising ϵ -caprolactam or 0.5-3% inorganic salts.

Pedrazzi, in the analogous art of dyeing paper pulp, teaches the functional equivalence of adding ϵ -caprolactam and N-methyl-2-pyrrolidone to paper pulp dyeing

Art Unit: 1796

compositions comprising the instantly claimed dyes of formula (1) (column 1, lines 50-67; column 4, lines 40-56). Furthermore, Pedrazzi teaches adding sizing agents such as aluminum sulphate to the compositions to produce brilliantly blue-dyed paper (column 5, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute ϵ -caprolactam for N-methyl-2-pyrrolidone in the compositions of Lacroix because Pedrazzi teaches their functional equivalence as additives in paper pulp dyeing compositions to produce papers with excellent light fastness and high brilliance. It would have been further obvious to incorporate aluminum sulphate into the compositions of Lacroix and optimize this concentration for maximal sizing benefit to the instantly claimed proportions because Pedrazzi teaches this compound as efficient in producing brilliantly blue-dyed paper.

4. Claims 1-8,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacroix (US 4,111,650) in view of Wunderlich (US 5,489,330).

Lacroix teaches dyeing paper pulp with compositions comprising 15-50, preferably 20-25 % % dyes of the instantly claimed formula (1), water, 8-12% N-methylpyrrolidone, 4-6% benzyl alcohol, and 4-5% formic acid (column 1, lines 5-40; column 2).

Lacroix does not teach compositions comprising ϵ -caprolactam or 0.5-3% inorganic salts.

Wunderlich, in the analogous art of dyeing paper pulp, teaches the functional equivalence of adding ϵ -caprolactam and N-methyl-2-pyrrolidone as solubility enhancers to paper pulp dyeing compositions comprising the dyes very similar to the instantly claimed dyes of formula (1) (column 1, lines 25-50; column 2, lines 45-55; column 3, lines 35-50). Furthermore, Wunderlich teaches adding sizing agents such as aluminum sulphate to the compositions to produce uniformly dyed brilliantly turquoise paper (column 4, lines 1-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute ϵ -caprolactam for N-methyl-2-pyrrolidone in the compositions of Lacroix because Wunderlich teaches their functional equivalence as additives in paper pulp dyeing compositions to enhance solubility. It would have been further obvious to incorporate aluminum sulphate into the compositions of Lacroix and optimize this concentration for maximal sizing benefit to the instantly claimed proportions because Wunderlich teaches this compound as efficient in producing uniformly dyed brilliantly turquoise paper.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMINA KHAN whose telephone number is (571)272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

Art Unit: 1796

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

/Amina Khan/
Examiner, Art Unit 1796
March 30, 2008